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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/759,312

01/19/2004

Brian John Melody

31433-57

8319

7590

03/07/2006

NEXSEN PRUET, LLC  
Post Office Box 10107  
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EXAMINER

NGUYEN, HA T

ART UNIT

PAPER NUMBER

2812

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/759,312

Applicant(s)

MELODY ET AL.

Examiner

Ha T. Nguyen

Art Unit

2812

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

HA NGUYEN  
PRIMARY EXAMINER

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Notice to applicant***

1. Applicants' Amendment and Response to the Office Action mailed 8-22-5 and Request for a Continued Examination have been entered and made of record. Following is an Office Action responding to the request.

### ***Claim Rejections - 35 USC, § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(a) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogino et al. (USPN 6236561, hereinafter "Ogino") in view of Kuwano et al. (USPN 6235842, hereinafter "Kuwano"), and Hernandez (USPN 4594641) or Knecht et al. (USPN, hereinafter "Knecht") and Hayase et al. (USPN 6686085, hereinafter "Hayase") or Kuwano et al. (USPN 6235842, hereinafter "Kuwano").

Referring to Figs. 1A-8C and related text, Ogino discloses [Re claims 1-2 and 7-13] a method, and inherently a device made by the method, of manufacturing a solid electrolytic

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capacitor, said method comprising: forming a solid electrolytic capacitor element 1; connecting the capacitor terminals to the capacitor element; and encapsulating the capacitor element and a portion of the capacitor terminals with a protective resin (See col. 3, line 36- col. 4, line 50).

But Ogino fails to disclose expressly applying a pre-coat resin to a portion of capacitor terminals; wherein said pre-coat resin is a lactone resin comprising a butyrolactone and an epoxy resin , which is substantially rigid at ambient temperatures and flexible at elevated or above ambient temperatures.

However, the missing limitations are well known in the art because Hernandez discloses applying a pre-coat resin to a portion of capacitor terminals; wherein said pre-coat resin is a resin comprising an epoxy resin , which is substantially rigid at ambient temperatures (See col. 4, line 59- col. 5, line 32). A person of ordinary skill is motivated to modify Ogino with Hernandez to obtain a well-protected capacitor that can be automatically insertable (see Hernandez, col. 3, lines 36-41).

Knecht also discloses applying a pre-coat resin to a portion of capacitor terminals; wherein said pre-coat resin is a resin comprising an epoxy resin , which is substantially rigid at ambient temperatures; and [Re claims 3-6 ] that the coating material can be applied by any suitable method known in the art, including using a wiper, a brush, a counter-rotating wheel assembly or by spraying (See col. 3, line 37-col. 5, line 12). A person of ordinary skill is motivated to modify Ogino with Knecht to obtain a well sealed capacitor.

The combined teaching of Ogino and Hernandez or Knecht fails to disclose expressly that the liquid epoxy resins contain butyrolactone.

However, the missing limitation is well known in the art because Hayase or Kuwano discloses this feature (See Hayase, example 29 or Kuwano, col. 18, line 49-col. 19, line 8).

A person of ordinary skill is motivated to modify Ogino and Hernandez or Knecht with Hayase or Kuwano to obtain an epoxy of desired consistency for a specific application and to use a well-known organic solvent to use with epoxy resin to have resin mixture of better characteristics.

Note that in the combined teaching of the applied references, the pre-coat resin would have the claimed characteristics because it is made of the same material as that of the claimed invention.

Therefore, it would have been obvious to combine Ogino with Hernandez or Knecht, and Hayase or Kuwano to obtain the invention as specified in claims 1-13.

### ***Double Patenting Rejection***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-5, 7-8 and 13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 3-9, respectively, of U.S. Patent No. 6845004. Although the conflicting claims are not identical, they are not patentably distinct from each other because the new set of claims contain all the limitations of the claims of the patent but broader in scope.

### ***Response to applicants' arguments***

6. In view of Applicants' arguments and amendment to the claims, the rejection of claims 1-16 under 35 U.S.C. 112 first paragraph is rendered moot.

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In view of Applicants' arguments and the amendment to the claims, the rejections of claims 1 and 3-6 under 35 U.S.C. 103, as stated in the immediately preceding Office Action, has been withdrawn.

Applicants' arguments with respect to the rejections stated in the indicated Office Action have been rendered moot in view of the new ground of rejection given above.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ha T. Nguyen whose telephone number is (571) 272-1678. The examiner can normally be reached on Monday-Friday from 8:30AM to 6:00PM, except the first Friday of each bi-week. The telephone number for Wednesday is (703) 560-0528.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael S. Lebentritt, can be reached on (571) 272-1873. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HN

03- 03 -06



Ha Nguyen

Primary Examiner